



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/557,580

03/24/2006

Hisanori Akiyama

125973

9054

25944 7590 09/23/2010

OLIFF & BERRIDGE, PLC

P.O. BOX 320850

ALEXANDRIA, VA 22320-4850

EXAMINER

MINSKEY, JACOB T

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

09/23/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com

jarmstrong@oliff.com

Office Action Summary	Application No. 10/557,580	Applicant(s) AKIYAMA, HISANORI	
	Examiner JACOB T. MINSKEY	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/31/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/15/2010 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.
3. The presented arguments paired with the amendments to the claims required a new search in which USP 5,425,665 was discovered. A new ground of rejection is presented below.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1791

5. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Kennedy, USP 5,425,665.

6. Regarding claim 1, Kennedy teaches a method and apparatus for manufacturing a spectacle lens (see title) sets based on order information (see figure 8 and column 1 lines 21-44) comprising a lens forming step of forming a circular plastic material (see column 1 describing attaching lens material to block) where the block aides in forming the shape of the lens by positing it to be processed in the desired shape (see summary of invention, column 2), wherein the lens member is a lens blank (item 44, figure 2 and column 4 line 30) and that the forming step comprising using the order information to first set the geometric center, then to calculate the position of the optical center based off of provided information such as pupil distance, frame distance, distance between lenses, and other provided measurements (column 6 line 42 – column 8 line 4, and figures 8 and 9). The method of Kennedy demonstrates the known method of setting a lens blank by its geometric center and then forming the optical center from that point utilizing provided measurements to form both lenses in a special frame.

7. Regarding claim 3, Kennedy further teaches that a computer is utilized to control the positing of the block and blank so that the angle, distance in X direction, and distance in the Y direction is automatically controlled to block out the lens during rotation and formation (columns 7 and 8).

Art Unit: 1791

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 2 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy, USP 5,425,665 in view of Miyazawa et al, US Patent Publication 2003/0181133.

11. Regarding claims 2 and 4, Kennedy implicitly teaches that the blank utilized has a smallest diameter that is at least as big as the maximum distance of the order is performed by the QC check at the bottom of column 7. There is enough of a teaching by Kennedy that would allow for an average artisan to realize that the blank had to be at least as big as the order in order for the product to be produced.

12. Kennedy remains as applied in claim 1 above, but is silent on the limitations of selecting a blank from a pool of blanks that are prepared in advance.

Art Unit: 1791

13. In the same field of endeavor of forming spectacle lenses through controlling the optical center of the final product, Miyazawa is utilized for the sole purpose to show that it is known in the art at the time of the invention to provide a selection of lens blanks made in advance to be selected for the formation steps of the actual lens.

14. Miyazawa teaches that the lens member forming step uses a lens blank (semi-finished lens, [0044]) of which both the surface have not yet processed to the curved surface shape satisfying the optical specification of the spectacle lens related to the order [0044] but processed to a predetermined surface shape as the plastic material of a processing target, and is able to process the spectacle lens related to the order appropriately out of a plurality of lens blanks manufactured and prepared in advance [0044-0045], and wherein the lens blank having an outside diameter at least larger than a maximum distance between a frame center and a frame of the spectacle frame related to the order and having the smallest outside diameter as well ("the semi-finished lens, therefore has a thickness relatively larger than a finish thickness" [0044]) is selected and processed so that the spectacle lens related to the order is manufactured (optimum semi-finished lens to be machined is selected from the stock [0045]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize Miyazawa's process of making blanks in advance to be readily utilized by the main process in the Kennedy method for the benefit of having a blank with all known values already prepared prior to lens shaping. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield

Art Unit: 1791

predictable results.” KSR Int’l Co V. Teleflex Inc, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007).

15. Regarding claim 5, Kennedy further teaches that a computer is utilized to control the positing of the block and blank so that the angle, distance in X direction, and distance in the Y direction is automatically controlled to block out the lens during rotation and formation (columns 7 and 8).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACOB T. MINSKEY whose telephone number is (571)270-7003. The examiner can normally be reached on Monday to Friday 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Matthew Daniels can be reached on 571-272-2450. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1791

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JTM

/Matthew J. Daniels/
Supervisory Patent Examiner, Art Unit
1791